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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,808	02/11/2002	Brian T. Holland	CM-103A US	4382

24804 7590 07/11/2005

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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,808

Applicant(s)

HOLLAND ET AL.

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11,13-15,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,13-15,22 and 23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/05/04 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "in an amount effective" in claim 22 is a relative term, which renders the claim indefinite. The term "in an amount effective to minimize formation of crystals..." is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what range or amount of dispersant in the composition is claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claim 22 (as best understood) is rejected under 35 U.S.C. 102(b) as being anticipated by Wirth et al.

Wirth et al. discloses all the limitations of claim 22, as best understood, i.e., a composition comprising organic acid (col. 6, line 35), a metal oxide (col. 18, line 65), a and dispersant (col. 4, line 36).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7, 9-11, 13-15, 22 (as best understood) and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. in view of Lum et al. (6,409,782).

George et al. discloses all the limitations of claims 9, 10, 22 (as best understood) and 23, i.e., a composition comprising organic acid, a metal oxide (color enhancer/hardeners, e.g., tin oxide 03:63), and a plasticizer, e.g., linear alcohol or secondary alcohol, wherein the organic acid is about 1 to 50 weight percent; metal oxide is about 1-50 (col. 3, last line) and the "plasticizer" is about 0 to 5 percent, except for the size of the metal oxides and amount of "dispersant" present. Although the size and the amount of components depending on workpiece and/or operational parameter are considered obvious modification to one of ordinary skill in the art, Lum et al. is cited. Lum et al. teaches the use of coloring agent or pigments of 2.5 to 4 microns.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of George et al. with the particle size as taught by Lum et al. to assist in refreshing the color of the workpiece during polishing.

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Regarding claims 2-7, 11 and 13-15, George et al. as modified by Lum et al. meets the limitations, e.g., dispersant, thickener (col. 3, lines 49-53 and col. 5, lines 20-37); water and wherein the composition is used to buff a stone surface.

8. Claims 22 (as best understood) and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirth et al. in view of Lum et al. (6,409,782).

Wirth et al. discloses all the limitations of the above claim, except for the size of the metal oxides and amount of "dispersant" present. An obvious modification in view of Lum et al. as indicated above in section 7.

Response to Arguments

9. Applicant's arguments filed 11/03/04 and 08/05/04 have been fully considered but they are not persuasive. The argument that one of ordinary skill in the art would know what is meant by an "effective amount" and that paragraph 25 and examples suggest a range, is not persuasive to withdraw 112 2nd rejection of claim 22. Specification as originally filed does not describe any "effective amount" to minimize formation of crystals larger than 100 Å. Nothing in the specification as originally filed defines the effective amount or what constitutes "minimization", if applicant means a range (e.g., 0.1 to 10) by the effective amount, then the relative term of minimization, would imply another range (acceptable within the definition of minimizing formation of crystals), which would result in reciting a range within a range. The Examiner considers the language as recited indefinite.

The argument that George et al. does not disclose a "dispersant" is not persuasive. A dispersant as described in the specification as originally filed, e.g., paragraph 28 defines a substance that promotes the formation and stabilization of one substance in another, as such even water as disclosed by George et al. in col. 3, lines 41-48 meets the limitation.

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The argument that Wirth et al. does not disclose any specific amount to meet the limitations of claim 22, it is noted, again, that claim 22 does not set limits or defines the amount claimed, thus any amount may be considered to minimize the crystallization.

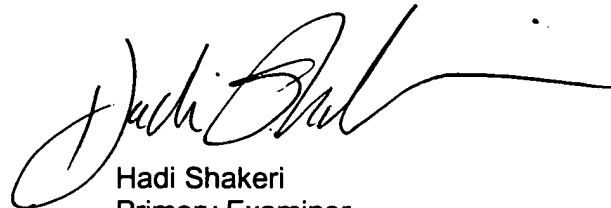
Applicant's arguments with respect to claims 9, 10 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri
Primary Examiner
Art Unit 3723
July 7, 2005